



STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W., SUITE 600
WASHINGTON, DC 20005-3934

Paper No. 7

COPY MAILED

APR 16 2002

In re Application of
De La Monte, et al.
Application No. 09/964,667
Filed: September 28, 2001
Attorney Docket No. 0609.4370005

OFFICE OF PETITIONS
DECISION ON PETITION

This is a decision on the "Petition for Acknowledgment of Deposit of Item with Originally-Filed Nonprovisional Patent Application Papers," which is being treated as a petition under 37 C.F.R. §1.53(e)(2), to, in effect, withdraw the "Notice to File Corrected Application Papers" as mailed November 7, 2001.

Application papers in the above-identified application were filed on September 28, 2001. However, on November 7, 2001, the Initial Patent Examination Division mailed applicants a "Notice to File Corrected Application Papers." Applicant was notified that the application papers had been accorded a filing date; however, figures 1a-1c described in the specification appeared to have been omitted. In addition, applicants were required to submit substitute drawings in compliance with 37 CFR 1.84.

In response, applicant filed the instant petition¹, contending that figures 1a-1c were in fact deposited in the U.S. Patent and Trademark Office with the nonprovisional application papers on September 28, 2001. In support thereof, petitioner notes that:

FIG. 1, as filed ... is an informal drawing depicting a nucleotide and amino acid sequence listing contained on a single page. Applicants have prepared formal drawings that correspond to the originally-filed informal drawings. The formal drawings are being submitted concurrently with this petition. In preparing the formal drawings it was necessary to divide the sequence information depicted in the originally-filed FIG. 1 among three drawing sheets that have been labeled "FIG. 1A," "FIG. 1B," and "FIG. 1C." Applicants assert that the information contained in FIGS. 1A-1C is identical to that which was found in the originally-filed informal FIG. 1 drawing.

¹ It is within the Commissioner's discretion to dismiss a petition under §1.181(f) filed more than TWO MONTHS after the action complained of as untimely. However, in this instance, petitioner provided a petition including a statement that the Office communication in question was received at the correspondence address of record on January 11, 2002. This petition was filed within two weeks of receipt of the Office communication. A substantial portion of the set reply period had elapsed on the date of receipt. Furthermore, the Office communication was mailed between October 13, 2001, and January 2, 2002, when delivery of mail from the Office to certain regions of the country was delayed. Accordingly, the instant petition under §1.53(e) will be considered on the merits.

Petitioner's remarks do not dispute that the original application papers did not include figures labeled 1A-1C. A review of the file confirms that the original application papers filed September 28, 2001, included a sheet containing a drawing labeled "Fig. 1," and a preliminary amendment² amending the specification to describe Figures 1A, 1B and 1C. Since the drawings filed on September 28, 2001, did not include figures labeled "Fig. 1A," "Fig. 1B," and "Fig. 1C," the "Notice" mailed November 7, 2001, was correct in advising applicants that drawings of these figures appeared to have been omitted. Therefore, the "Notice" was properly mailed and will not be withdrawn.

The petition is DISMISSED.

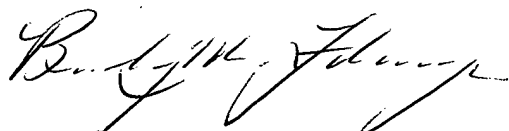
The petition fee will not be refunded, since the petition was not necessary to correct any PTO error. Figs. 1A, 1B, and 1C were not received by the PTO on September 28, 2001.

Receipt of the substitute drawings and the "Petition to Restart Period for Reply" filed January 25, 2002 are acknowledged. The proposed drawing correction to Fig. 1 (to Fig. 1A, 1B and 1C) will be considered by the primary examiner in due course. See MPEP 608.02(h). As to the timely filing of the substitute drawings in reply to the "Notice to File Corrected Application Papers," the OIPE will consider the "Petition to Restart Period for Reply."

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of September 28, 2001, using the drawings filed on that date.

Applicant will receive appropriate notifications regarding the fees owed, if any, and other information in due course from OIPE.

Telephone inquiries related to this decision should be directed to Petitions Attorney Nancy Johnson at 703-305-0309.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

² A preliminary amendment not filed along with the original application does not enjoy the status of part of the original disclosure. See MPEP §608.04(b). However, the instant preliminary amendment was filed with the original application papers and thus, was properly considered by the Office in concluding that the figures described in the specification as amended appeared to have been omitted.